

Appl. No. 10/820,617
Amdt. Dated June 9, 2006
Reply to OA of March 6, 2006

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REMARKS

The Office Action rejected claims 5-10 under 35 U.S.C. § 112, ¶ 2 as being indefinite. While the Applicant disagrees with this rejection and therefore traverses it, the Applicant has amended claim 5 to clarify the claims. Claim 5 has been amended into independent form, which includes the elements of previously presented claim 3 along with the scoring goal elements of claim 5 as previously amended. Applicant believes this overcomes the rejection.

The Office Action rejected claim 1 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 697,574 to Walenta and claims 2-5 and 7-20 under 35 U.S.C. § 103(a) as being unpatentable over Walenta. Tellingly, the Examiner failed to provide a second reference to make the obviousness rejection. All of these rejections are erroneous.

Walenta relates to a game and associated apparatus related to a spinning top C. The spinning top C is released by the top holder D onto the flat table A. The object of the game is to knock off balls G placed on top of elastic vertical pillars E and score points accordingly. Walenta does not disclose the use of game balls instead of a spinning top, nor does it include any disclosure of pitching balls from a marker to a scoring goal.

A. Walenta is not a proper 102 reference because it does not contain all of the limitations of the claims.

According to Section 2131.00 of the MPEP, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegall Bros. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)." At a minimum, Walenta lacks three critical elements of claim 1. First, Walenta lacks an inner scoring area. The Walenta game consists of "nine flexible and elastic vertical pillars E" (lines 59-60 and Fig. 1). The Examiner recites that the "Outer Pillars (point values 10, 15, 25) correspond to the recited scoring area. Inner pillar E (point value 100) corresponds to the inner scoring area." However, claim 1 requires "an inner scoring area having a perimeter." The center pillar

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(point value 100) lacks a perimeter as required by the claim and therefore does not meet this limitation.

Second, Walenta lacks a marker. In fact, the Examiner mistakenly asserts that pins H located in the middle of the game board A comprise a marker. However, that cannot be so because the claim requires "a marker, placed at one end of the playing surface." Pins H are clearly not located at an end of the game table, assuming that qualified as a playing surface. The reason why Walenta lacks a marker is that it is not directed at a ball pitching game. Rather, it uses a top holder D in lieu of a marker to control the initiation by a player of the top C.

Third, Walenta lacks game balls for pitching or rolling. Although the Examiner argues that "Balls G are inherently capable of being place[d] on top of the game pole as well as inherently capable of being pitched or bowled at the pillars," this is counterintuitive. As discussed above, Walenta employs a spinning top C, not game balls. And the pillars E located at the front of the game table as well as the top holder D would obstruct a player attempting to roll or pitch a ball in any event.

Because Walenta lacks all three of these claim elements, it cannot be a basis for rejecting claim 1 under Sections 102 or 103. The Examiner should therefore withdraw this rejection.

B. Walenta is not a proper 103 reference even if the Examiner is allowed to make such rejection without a second source to combine with Walenta.

As set forth above, this rejection is improper with respect to claim 2 through 10 because Walenta lacks the above three elements. With respect to claim 2, Walenta lacks a marker, an inner scoring area, and game balls. Claims 3 and 4 require "at least three inner poles inserted into the playing surface forming an inner scoring area." Walenta lacks both three inner poles as well as an inner scoring area. Walenta also lacks the marker and game balls recited in these claims.

With respect to claims 5 through 10, Walenta lacks both the marker and game balls as well as "four inner poles inserted into the playing surface forming an inner square." It further lacks "an inner boundary formed by the inner poles" as recited in the claims. Additionally, Walenta also lacks a line attached to the outer and inner poles (claim 6),

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inner poles with different colors (claim 7), game balls with different colors and corresponding markings (claim 8), four game balls all having different colors (claim 9), and scoreboard (claims 2 and 10).

The Examiner's repeated and general reliance on what hypothetical persons of ordinary skill in the art would know is improper. The Office Action employs the knowledge of a hypothetical person of skill in the art to supply several claim elements, including multiple inner pillars, differently colored balls, and differently colored poles. But the Examiner fails to provide any basis for why one modify the game table of Walenta to include these changes, particular given the fact that Walenta employs a spinning top, not game balls. As Section 2142 of the MPEP explains, "When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986)." The Office Action fails to meet this requirement.

For the multiple reasons set forth above, the rejections under 103 are in error and should be withdrawn.

CONCLUSION

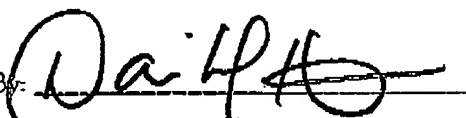
The Applicant respectfully requests the Examiner to make the above amendment, withdraw all pending rejections, and allow the patent to issue. Any questions regarding this response should be directed to the undersigned attorney for Applicant.

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Respectfully submitted,

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CASH KLEMCHUK POWERS TAYLOR LLP
Attorneys for Applicant

By: 

Darin M. Klemchuk
Registration No. 47,709

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8150 N. Central Expressway
Suite 1575
Dallas, Texas 75206
Tel: 214/239-8900
Fax: 214/550-2671